

REMARKS

Favorable reconsideration of this application as presently amended is respectfully requested. Claims 1-20 are pending. In this Amendment, claim 5 is canceled, and claims 1, 2 and 10 are amended. No new matter is added.

The drawings have been objected to under 37 CFR 1.83(a) on the basis that the drawings must show every feature of the invention specified in the claims.

A new Figure 9 has been added showing a third largest sized display case, in accordance with the terms of claim 8 as originally filed.

A new Figure 10 has been added showing a hook and loop connectors as described in original claims 4,11 & 14 and described at the last paragraph of page 7, wherein it is stated:

“To improve the user’s ability to position the display cases and create a desirable overall display, a hook and loop connector, such as sold under the trademark Velcro[®], or other means for reversible attaching two or more display cases together, can be added to the wall elements and preferably to the rear wall elements. This can include strips or swatches of Velcro[®], placed so that the display cases can be aligned into a preferred display arrangement and attached together securely to prevent inadvertent movement.”

Accordingly, no new matter has been entered.

A corrected drawing sheet, in compliance with 37 CFR 1.121(d), is submitted here with, in reply to the Office action to avoid abandonment of the application. The amended

replacement drawing sheet includes all of the figures appearing on the immediate prior version of the sheet. The replacement sheet(s) has been labeled "Replacement Sheet" in the page header (as per 37 C.F.R. 1.84(c)) so as not to obstruct any portion of the drawing figures.

Claims 2, 5-6 and 8-20 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner has indicated that Claims 2 & 8-9 are viewed as being misdescriptive of the disclosed embodiments since the drawings do not depict "smaller sized display cases" being stored within "larger sized display cases" (the figures do not support the recitation of a "third" display case]. The addition of new Figure 9 overcomes this objection by making the drawings conform to the language of the claims. Support for the modification of the drawings is found in the last paragraph of page 7, which reads as follows:

The third case has external dimensions of eighteen inches across by four and one half feet high on the side elements. The case is assembled as described above. Carpet and plywood are again used for the external appearance. The third case is designed to be stackable on top of or nested inside the second.

Accordingly, new Figure 9 is fully supported by the specification and claims as filed.

The examiner has noted a typographical error in Claim 2. The error has been corrected by deleting the superfluous language, "18. The method of claim 16 further..." The typographical error in Claim 5 has been corrected by replacing "objectons" with –

object on -, or within...”

In Claim 10, the phrase “elements are covered with carpet or a fire retardant fabric” is viewed by the examiner as being unclear in the sense that it is not clear if both cases i.e., the smaller and larger cases, each have a covering. The language of the claim has been modified to make it clear that a display case is covered with carpet or a fire retardant fabric. The claim, by specifying that a display case is so cover, does not exclude covering other display cases.

Claims 1-2 & 5-9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Grogan [U.S. Patent No. 6,325,281]. It is the examiner’s position that Grogan (figures 1-4) teaches of a plurality of display cases (30, 40 for example); wherein the display cases are of increasing size (30 bigger than 40), and wherein the smaller sized display case is of a dimension such that that it is capable of being stored inside the larger sized display case, and wherein the display cases are capable of being attached to each other (such as in a nested arrangement) to form a single display unit, wherein each display case is comprised of upper, lower, front, rear and side elements (all disclosed in the specification), wherein the lower, front, rear and side elements of the display case are composed of polystyrene foam [expanded & open-cell polystyrene], wherein the lower element of at least the small case connects to the front, rear and side elements along the bottom edge of the front, rear and side elements, wherein the front, rear and side elements connect to one another along the vertical edges of the front, rear and side elements, wherein the lower, front, rear and side elements form a container capable of storing items for display, wherein the upper element (62, 63) forms a removable lid that fits within the front, rear and side elements, and wherein the lid for the larger container contains a top surface (61) capable of holding

displayed items.

The examiner acknowledges that Grogan does not 1) specifically state a method of storing, transporting and displaying an object, or 2) show the vertical elements of the larger case as being connected to the lower element along an edge [appears that the vertical and lower elements are integrally formed]. It is respectfully submitted that the Grogan disclosure is limited to a thermally insulating shipping system and not to a display system. The differences between the patent and the claim has been emphasized by virtue of the amendment to the claims that provides for the step of “b) storing at least one smaller display case inside at least one larger sized display case, and c) transporting, storing and displaying the one or more art objects on or within the display case system.” While Grogan might be capable of such uses, the claims go beyond providing a structure having such capabilities, but rather, specifies the steps transporting, storing and displaying. It is noted that the term “displaying” or any equivalent thereof is not found in the Grogan patent. The term display is defined in the Merriam-Webster dictionary as

a : to put or spread before the view <*display* the flag>

b : to make evident <*displayed* great skill>

c : to exhibit ostentatiously <liked to *display* his erudition>

While the Grogan structure might be capable of having an object placed on it, or in it, using the device to display an art object is not suggested in any way in the patent.

Thus, while it is the examiner’s position that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to a) provide a display case and b) store, transport and display an object as prescribed by applicants method because the normal use of Grogan’s structure would inherently accommodate such steps as

set forth since Grogan teaches of a structurally similar device and the device is used to transport items while having the ability [level upper surface —fig. 1] to place one of the items on the case either before or after shipping, such use is NOT described or suggested by the patent. Having an ability to be used in a particular manner is definitely not a teach to use a device in a particular manner. It is well settled law that the teaching to use the device of a prior art patent in the manner of a claim, must be based on a teaching or suggestion in the prior art.

It is the examiner's position that "[a]s to the construction of the display cases, it is viewed that forming the case as an integral member or forming the case from a plurality of elements does not distinguish the invention from the prior art in terms of patentability since the construction of the case lacks a new or unobvious functional relationship to the case itself. As to claim 5, an item may be stored within the cases of the prior art or on the cases as dictated by the user's needs or situation as readily apparent to the examiner."

It is respectfully submitted that the foregoing basis for a rejection of a claim is not support by statute or judicial decision. In fact, it is in direct conflict with the current state of the law. The teachings or suggestions must be based on the patent, rather than on a hindsight analysis of the situation.

It is the examiners position as to claim 6, that the nested cases (fig. 4) may be separated (fig. 3) and the cases placed adjacent to each other as dictated by the user's needs or situation. As to the inclusion of more display cases within the system, it is viewed that the addition of another smaller case may be implemented depending upon the needs of the user, since such duplication of the parts i.e., an additional case, involves only routine skill

in the art. The examiner has failed to note that the claim specifies, "...attaching the cases to each other to form a single display system having display cases of varying size...". There is no logical reason to attaches the cases of Grogan to each other to form a single display system.

Claim 3 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Grogan in view of Sabol Jr., [U.S. Patent No. 6,264,527]. It is the examiner's position that Grogan teaches applicants inventive claimed structure as disclosed above, but acknowledges that Grogan does not show the elements of the case being connected via rabbetted joints with the aid of an adhesive. Sabol is cited as an evidence reference to show that it was known in the art to join elements of a case together with the use of rabbetted joints and an adhesive. However, Sabol relates to a "Multi-Voiced Turkey Call and Improved Sounder Board Arrangement To Simulate Young Turkey Calls". There is no logical reason to take the teaching from Sabol, apply it to Grogan in order to product a structure that has particular utility when used for a purpose not anticipated by Grogan or Sabol. The structure of the display case is essential because of the requirements of low cost, structural rigidity and high aesthetic quality. Clearly, the rejection is a hindsight assembly of unrelated features from the prior art. The rejection is tantamount to rejecting the claims based on a product supply catalog that offers for sale a multitude of unrelated components.

It is acknowledge that the Sabol arrangement would provide Grogan with a more stable and semi-permanently erected case that is constructed without the aid of tools and mechanical fasteners yet is more structurally sound due to the interconnection of the jointed elements [as opposed to joining elements along a single flat surface]. However, this structural stability is not indicated by Grogan as being required or needed and in fact,

appears to be unnecessary, since Grogan relies on the structural qualities of the outer corrugated board container to structural integrity.

Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Grogan in view of Thor [U.S. Patent No. 4,194,657]. The examiner acknowledges that Grogan does not show a side element containing a hook and loop connector to allow for multiple cases to be attached. Thor (figures 1-5) is cited as an evidence reference to show that it was known in the art to utilize a hook and loop connector (49) on a side element of a case for the purpose of attaching the case to another object with a mating hook and loop connector. Even assuming, *arguendo*, that the statement about Thor is correct, there is no logical reason to apply this teaching to Grogan. In fact, applying this teaching to Grogan would lack utility, absent the teachings of the present invention. Accordingly, it would definitely NOT have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the case of the Grogan so as to incorporate a hook and loop connector (Velcro) onto a side element of Grogan's case as taught by Thor because this arrangement would have not utility in the Grogan system.

Claims 10, 12-13 & 16-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Grogan in view of Morrison [U.S. Patent No. 4,325,597]. The examiner acknowledges that Grogan does not show a carpet or fabric covering some of the elements. Morrison (figures 1-49) has been cited as an evidence reference to show that it was known in the art to utilize a fabric or carpet to cover elements of a structure. However, there is a complete lack of any disclosure, teaching or suggestion on which to base the modification of Grogan in view of Morrison (other than the present disclosure). Accordingly, based on the current state of patent law, there is no basis for stating that it would have been obvious

to a person of ordinary skill in the art at the time the invention was made to modify the case of the Grogan so as to incorporate a fabric or carpet layer on the case's elements as taught by Morrison because this arrangement would provide the case of the prior art with a more esthetically pleasing appearance. It is noted that carpeting the Grogan structure would be illogical, if not absolutely absurd.

The examiner's remarks that it would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the type of material used to construct the case, overlooks the fact that the stated use of the system of the claims is totally different from that of the stated use of the cited patents. Thus, while a worker of ordinary skill in the art could have selected a known material on the basis of its suitability for the intended use, the intended use is ONLY found in the present application rather than in the prior art. The material is functionally related in a new or unobvious way to a display device that is used to exhibit ostentatiously an art object. It is not functionally related to the thermal shipping container of Grogan.

As to the bonding of the elements via an adhesive, the examiner takes the position that one of ordinary skill in the art at the time the invention was made would deem the incorporation of an applied adhesive to adjacently positioned elements for the purposes of securely attaching the elements in a prescribed configuration as an obvious adaptation not rising to the level of novelty for patentability purposes. It is respectfully submitted that the adaptation has unique value when used to produce a light weight shipping container that can be also used as a display case. It has no utility in relation to Grogan.

Claims 11 & 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over

Grogan and Morrison and further in view of Thor. The examiner acknowledges that the prior art does not show a side element containing a hook and loop connector to enable multiple cases to be attached. The only purpose of such attachment is in the use of the structure of the claims as a display case system. The prior art totally lacks any motivation to make the examiner's suggested combination. It may have been known in the art to utilize a hook and loop connector on a side element of a case for the purpose of attaching the case to another object with a mating hook and loop connector, but it is not known in the art to apply such a system to produce a display case system. Attaching multiple display cases together is not taught, disclosed or suggested by the prior art. Accordingly, it would NOT have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the case of the prior art so as to incorporate a hook and loop connector (Velcro) onto a side element of the prior art's case as taught by Thor, because the art at the time the invention was made failed to recognize, disclose, teach or suggest that this arrangement would produce a structure having particular utility as a display case system.

Claim 15 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Grogan and Morrison and further in view of Sabol Jr. The examiner acknowledges that the prior art does not show the elements of the case being connected via rabbetted joints. While rabbetted joints may be known in the art to join elements of a case together, there is no basis found in the teachings of the prior art, for applying such a system to the shipping container of Grogan. Grogan relies on the outer corrugated box for structural rigidity and the foam interior function as thermal insulation. Application has come up with the unique idea of using thermal insulation boards, not for their thermal properties, but rather for their combination of structural strength and light weight. Applicant's system has utility as a display case system.

Clearly, it would not have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the element joining means of the prior art by utilizing the rabbetted joints as taught by Sabol, because a use for this arrangement is not found in the prior art.

Conclusion

The prior art fails to provide any teach, disclosure or suggestion to make the combination as defined in the claims. The current law explicitly requires that a motivation for making a combination of reference be found in the references themselves, rather than in the patent application.

If the Examiner has any questions or concerns regarding the present response, the Examiner is invited to contact Sheldon H. Parker at 703-591-2664, Ext. 2041.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance, and favorable action is respectfully solicited.

Respectfully submitted,



Sheldon H. Parker
Reg. No. 20,738

JAGTIANI + GUTTAG
Democracy Square Business Center
10363-A Democracy Lane
Fairfax, Virginia 22030
703-591-2664

January 28, 2005

Amendments to the Drawings

The attached sheet of drawings includes new FIGS. 9-10. This sheet, which includes FIGS. 9-10, becomes new Sheet 5 of the drawings. A new Figure 9 has been added showing a third largest sized display case, in accordance with the terms of claim 8 as originally filed. A new Figure 10 has been added showing a hook and loop connectors as described in original claims 4, 11 & 14 and described at the last paragraph of page 7, wherein it is stated:

“To improve the user’s ability to position the display cases and create a desirable overall display, a hook and loop connector, such as sold under the trademark Velcro[®], or other means for reversible attaching two or more display cases together, can be added to the wall elements and preferably to the rear wall elements. This can include strips or swatches of Velcro[®], placed so that the display cases can be aligned into a preferred display arrangement and attached together securely to prevent inadvertent movement.”

Support for the new Figures is found in the originally claims 4, 11 and 14 and the last paragraph of page 7 of the specification.

Attachment: One Replacement Sheet, One Annotated Marked-up Drawings